

Applicant: EBERLE *et al.*
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REMARKS

In response to the Non-Final Action mailed **June 23, 2010** (hereinafter "Office Action"), no claims have been amended, cancelled, or newly added. Therefore, claims 27, 29-32, 34-38, 40-51, 54, 56-59, 61-65, and 67-78 remain pending. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

INFORMATION DISCLOSURE STATEMENT

Applicants are submitting herewith a Supplemental Information Disclosure Statement and respectfully request that the Examiner consider the cited references and provide a signed copy of the Form PTO-1449 for this submission with the next Office Action.

REJECTION UNDER 35 U.S.C. § 112, ¶2

Claims 27 and 54 stand rejected under 35 U.S.C. § 112, ¶2, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner alleges:

Claims 27 and 54 lines 13 and 15 recites "the telephone" which is unclear and confusing if this pertains to the outbound telephone call or if this is a new telephone call. Appropriate clarification and/or correction is required.

[Office Action, pg. 2, ¶4].

Applicants traverse this rejection because the recitation of "the telephone" does *not* appear in either independent claim 27 or independent claim 54. Accordingly, the basis for the alleged rejection is not clear. Regardless, independent claims 27 and 54 are clearly definite and would not prevent a person of ordinary skill in the art from interpreting the metes and bounds of the claims. See *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) ("Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite."). For at least the foregoing reasons, the

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rejection of independent claims 27 and 54 under 35 U.S.C. § 112, ¶2 is legally improper and should be withdrawn.

ALLOWABLE SUBJECT MATTER

Applicants thank the Examiner for the indication of allowable subject matter. The Examiner has indicated that claims 51 and 78 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims [Office Action, pg. 2, ¶12].

REJECTIONS UNDER 35 U.S.C. § 103

Claims 27-38, 40-50, 54-65, and 67-77 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,144,938 to Surace *et al.* (hereinafter "Surace") in view of U.S. Patent No. 5,873,032 to Cox *et al.* (hereinafter "Cox") [Office Action, pg. 3, ¶17]. Applicant traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the Examiner has failed to address amendments and arguments presented in a previous Response.

For example, in the previous Amendment submitted June 1, 2010, Applicants amended independent claims 27 and 54, *solely* in an effort to expedite prosecution, to clarify aspects of the invention. Applicants additionally argued that, assuming arguendo that it were deemed legally proper to modify Surace to include the alleged teachings of Cox in the manner alleged by the Examiner (which Applicants do not concede), the references, even if combined, fail to disclose, teach, or suggest *at least* the following feature of independent claim 27:

service subscription means for receiving from at least one subscriber, during a subscription registration process, ... criteria for customizing the service output information based on a recipient of the outbound telephone call;

Independent claim 54 (a method claim) includes a similar recitation. Nowhere in the instant Office Action does the Examiner appear to even address the foregoing claim recitations. To establish *prima facie* obviousness of a claimed invention, all the claim

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limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In view of the foregoing, Applicants request that a new, Non-Final Office Action be issued addressing the claim recitations of each of the pending claims.

Dependent claims 51 and 78 are indicated as being allowable by the Examiner, and the remaining dependent claims 29-32, 34-38, 40-50, 56-59, 61-65, and 67-77 are allowable because they each ultimately depend from an allowable independent claim, as well as for the further features they recite.

CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: September 23, 2010

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